



United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,582	04/07/2004	Roger A. Sabbadini	078853-0311	8568
35938	7590 12/12/2005		EXAMINER	
BIOTECHNOLOGY LAW GROUP			TATE, CHRISTOPHER ROBIN	
C/O PORTE			ART UNIT	PAPER NUMBER
P.O. BOX 52050			AKTONII	FAFER NUMBER
MINNEAPOLIS, MN 55402			1655	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	10/820,582	SABBADINI, ROGER A.				
Office Action Summary	Examiner	Art Unit				
	Christopher R. Tate	1655				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address						
Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.						
 If NO period for reply is specified above, the maximum statutory perio Failure to reply within the set or extended period for reply will, by statution Any reply received by the Office later than three months after the mail earned patent term adjustment. See 37 CFR 1.704(b). 	ute, cause the application to become ABANDONE	D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 20 2a) This action is FINAL . 2b) The 3) Since this application is in condition for allow closed in accordance with the practice under	nis action is non-final. vance except for formal matters, pro					
Disposition of Claims						
4) Claim(s) <u>1-15</u> is/are pending in the application 4a) Of the above claim(s) is/are withdrest 5) Claim(s) is/are allowed. 6) Claim(s) is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) <u>1-15</u> are subject to restriction and/or	rawn from consideration.					
Application Papers						
9) The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119						
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
Attachment(s) 1) Notice of References Cited (PTO-892)	4) 🔲 Interview Summary					
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/0 Paper No(s)/Mail Date 	Paper No(s)/Mail D 5) Notice of Informal F 6) Other:	Patent Application (PTO-152)				

Application/Control Number: 10/820,582

Art Unit: 1655

DETAILED ACTION

Applicant's response with amendments filed 20 May 2005 has been received and entered. Upon further review, an Election of Species requirement is deemed necessary at this time as set forth below.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

- A. The three distinct diseases/disorders being treated (see, e.g., claims 13-15).
- B. The various distinct agents that bind a sphingolipid or sphingolipid metabolite (see, e.g., claims 2-4).
- C. The various distinct sphingolipids or sphingolipid metabolites (see, e.g., claims 5-7).
- D. The various distinct binding receptors (see, e.g., claims 8-12).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (i.e., elect a particular disease or disorder from among the three instantly claimed, elect an agent from among those instantly claimed, elect a particular sphingolipid or sphingolipid metabolite from among those instantly claimed, and elect a particular binding receptor from among those instantly claimed - including a particular SEQ ID NO if either rat Edge-3 or SCaMPER is elected as the receptor) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Please note that the examiner assigned to the instant application has changed.

Accordingly, any inquiry concerning this communication or earlier communications should be directed to examiner Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number: 10/820,582 Page 4

Art Unit: 1655

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher R. Tate Primary Examiner Art Unit 1655